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Malina Halina
12 , Res. Les Amonts
Les Ulis, 91 940
FRANCE

In re Application of
MALINA HALINA
U.S. Serial No.: 09/936,793
PCT Application No.: PCT/FR00/00757
Int. Filing Date: 23 March 2000
Priority Date: 26 March 1999
Attorney Docket No.: None
For: PROTEINS MODIFIED BY XANTHURENIC ACID

:COMMUNICATION
: REGARDING
:ABANDONMENT
:

This is in response to applicant's communication received via facsimile on 09 March 2004 in the United States Patent and Trademark Office (USPTO) in the above referenced application.

On 20 September 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which indicated that fees were to be charged to a credit card. The basic national fee for filing with European Patent Office search report as a small entity is \$430. However, a review of the finance records indicated that the basic national fee was not paid.

On 26 November 2001, a Notification of Abandonment was mailed to applicant indicating that the application was abandoned for failure to pay the basic national fee by the 30 month deadline.

On 13 December 2001, applicant filed a communication accompanied by a USPTO date-stamped itemized postcard receipt. The post card receipt indicated that a "credit card payment form" accompanied the national stage filing on 20 September 2001. However, applicant did not provide a copy of the originally filed credit card forms.

In a decision mailed on 03 April 2002, applicant was advised that although she provided proof with the itemized postcard receipt that the credit card form accompanied the original papers filed on 20 September 2001, applicant did not provide a copy of the originally filed forms in order to verify that the forms were properly filled out. Absent such a copy, the application must continue to be held abandoned.

On 18 February 2004, a second Notification of Abandonment was mailed to applicant, indicating that the U.S. basic national fee had not been provided.

On 09 March 2004, applicant filed via facsimile, a communication along with a new credit card form (Form PTO-2038) dated 09 March 2004 authorizing payment of the basic national fee.

DISCUSSION

The instant communication was accompanied by a new transmittal letter (Form PTO-1390) indicating the fees to be paid and a new credit card authorization form dated March 9, 2004. The basic national fee of \$430 was charged to applicant's credit card per her authorization.

However, the application remains abandoned. As explained in the 03 April 2003 decision, in order to vacate the abandonment, applicant must either provide a true copy of the originally filed credit card form filed on 20 September 2001. Without providing a copy of the originally filed credit card form, applicant cannot claim the benefit of timely payment of the basic national fee on 20 September 2001. If available, applicant should provide a true copy of the originally filed credit card form. In the alternative, applicant may wish to file a petition to revive the application under 37 CFR 1.137.

Petition to Revive Options

To revive her abandoned application, applicant may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137.

Under 37 CFR 1.137(a), a petition requesting that the application be revived on the grounds of unavoidable delay must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay, (2) a proper reply, (3) the petition fee required by law and (4) a terminal disclaimer and fee in all applications filed before 08 June 1995. The petition fee currently required by law is \$55.00 for a small entity.

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be accompanied by: (1) a proper reply; (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition fee currently required by law is \$665.00 for a small entity.

As stated in the MPEP §711.03(c), a petition under 37 CFR 1.137(b) is significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The Office is almost always satisfied as to whether "the entire delay was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay). A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(III)(C)(2). In addition, a petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR 1.137(a) end up being granted under 37 CFR 1.137(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of delay simply does not amount to "unavoidable delay" within the meaning of 37 CFR 1.137(a).

Since the requirements of 37 CFR 1.137(a) are more exacting than the corresponding requirements of 37 CFR 1.137(b), a petition under 37 CFR 1.137(a) is significantly less likely to

be grantable as filed than is a petition under 37 CFR 1.137(b). The Office usually must render a number of interlocutory decisions dismissing a petition under 37 CFR 1.137(a) and requesting additional evidence until either the applicant provides a satisfactory showing of unavoidable delay (in which case the petition can be granted) or the Office concludes that the applicant cannot provide a satisfactory showing of unavoidable delay (in which case the petition must be denied). Thus, the period between when an applicant first files a petition to revive and the Office renders a decision granting (or denying) that petition will, more often than not, be much longer if the petition is under 37 CFR 1.137(a) than it would have been if the petition were under 37 CFR 1.137(b). See Section 711.03(c) of the Manual of Patent Examining Procedure (MPEP) enclosed.

This suggestion with regards to the option of filing a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

Because applicant has filed the application *pro se*, it is noted that while an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent. Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, DC 20402. Registered patent attorneys and agents are also listed on the Internet at www.uspto.gov.

CONCLUSION

The application 09/936,793 remains abandoned.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: 703-306-5467
Fax: 703-308-6459

Enclosures: MPEP 711.03(c) including petition samples
Form PTO/SB/61/PCT
Form PTO/SB/64/PCT